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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/543,038

12/15/2005

Heinrich Sommer

7206-103

9189

62836 7590 10/06/2010  
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EXAMINER

COONEY, JOHN M

ART UNIT

PAPER NUMBER

1765

MAIL DATE

DELIVERY MODE

10/06/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/543,038	<b>Applicant(s)</b> SOMMER ET AL.	
	<b>Examiner</b> John Cooney	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-11 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-11 and 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4-12-10 has been entered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The range of log  $P_{o/w}$  values of claim 10 is in conflict with the log  $P_{o/w}$  values of claim 17. Claim 17 requires values of greater than or equal to 1.90 which would not allow for values between at least 1.35 and less than 1.90. Accordingly, claims are confusing as to intent.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6-11 & 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 198 31 285.

DE-'285 discloses preparations of prepolymer compositions comprising silane terminated polyurethane prepolymers as claimed, additives and catalysts, and (fluoro) alkane and/or alkyl ether propellants as claimed as well as methods of employing these propellants, including in mixture, in producing foams from these prepolymers (see the abstract and column 4, as well as, the entire document). As the  $P_{o/w}$  values of applicants' claims relate to properties intrinsically possessed by the propellants of the instant concern, it is held that the ranges of  $\log P_{o/w}$  values of applicants' claims are inherent to the teachings of DE-'285 because it discloses the propellants of applicants' claimed invention.

Applicants' arguments have been considered. However, rejection is maintained. It is maintained that in that the prepolymers and propellants of applicants' claims are employed in the preparations of the cited prior art, difference is not seen to be demonstrated for the products of the claims, and inherency as indicated in the rejection above is maintained to be evident.

Examiner maintains that formation of preparations involving the materials critical to achieving the results of applicants' claims, particularly the reactant materials of applicants' claims, propellants of applicants' claims, including isobutene, and

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trimethoxysilanes of applicants' invention and claims, are provided for by the disclosures of DE-'285. Accordingly, it is maintained that the effects, particularly the ranges of  $\log P_{o/w}$  values expressed by applicants' claims, are inherent to the teachings of DE-'285. Moreover, it is noted that the  $\log P_{o/w}$  values of applicants' claims appear to be mainly, if not solely, dependent upon propellant selection. Accordingly, it is seen that inherency of the ranges of  $\log P_{o/w}$  values of applicants' claims may be fully supported, solely, by DE-'285's anticipatory teachings regarding propellant selection.

Though an expressly exemplified embodiment of DE-'285 does not require each of the components identified above. It is maintained that the anticipatory teachings provided for by the four corners of DE-'285 provides for the combination identified above. Accordingly, it follows that the result of the claims arrived at through combination of the anticipated formulation identified above would also be inherently provided for by the anticipatory teachings provided for by the four corners of DE-'285. Burden is upon applicants to demonstrate difference in their claims based on physical difference in the claims over that which is anticipated by the teachings of DE-'285. At this time such difference is not seen to be demonstrated.

It is seen that DE-'285's disclosure of "Arbitrary combinations of these gases are possible" is sufficient to meet the requirements of applicants' new claim 19 in that claim 19 only requires mixtures without specific criteria as to amounts and/or make-up of the blends. Claim 10 is not seen to require blends because it may be read upon by a teaching to using one propellant, such as i-butane.

It is maintained that rejections under 35 USC 102 can not be overcome by showings of new or unexpected results, and the evidence discussed on reply does not serve to demonstrate how the products of the claims are different from the products of the cited prior art. The showing of other compounds within DE-'285 that may have lower log  $P_{o/w}$  values than those of the claims does not negate the teachings of DE-'285 when DE-'285 has anticipatory teachings of propellants that have log  $P_{o/w}$  values that meet the requirements of applicants' claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Cooney/

Primary Examiner, Art Unit 1796